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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/618,914 | 07/14/2003 | Dean L. Kamen | 1062/C90 | 7976 |
| 2101 | 7590 | 02/17/2005 | EXAMINER | |
| BROMBERG & SUNSTEIN LLP 125 SUMMER STREET BOSTON, MA 02110-1618 | | | SHRIVER II, JAMES A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3618 | |

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,914

Applicant(s)

KAMEN ET AL.

Examiner

J. Allen Shriver

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 18-23, 28 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/2/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species I (claims 1-15, 17 and 24-27) in the reply filed on December 6, 2004 is acknowledged.
2. Claims 16, 18-23 and 28-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 6, 2004.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on February 2, 2004 has been considered by the examiner.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Reference number "13", page 1, line 17 and Reference number "15", page 1, line 22 were not shown in the Drawings. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet"

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pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "12" has been used to designate both the support platform in Figure 1 and the handlebar in Figure 2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-8, 10, 12, 15, 17 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurschat (US Patent 5,064,209) in view of Malick (US Patent 3,399,742).** Kurschat discloses a transporter for transporting a first user and at least one additional rider over

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a surface (See Fig. 1), the transporter comprising a first support platform for supporting a first user, the first support platform having left and right sides and defining a fore-aft vertical plane and a lateral plane; at least one ground-contacting element coupled to the first support platform; a motorized drive arrangement for driving that at least one ground-contacting element so as to cause locomotion of the transporter; a controller for commanding the motorized drive arrangement; and one or more passenger platforms for supporting the at least one additional rider (See Fig. 1); **[claim 7]** wherein at least one auxiliary ground-contacting element is coupled to each of the passenger platforms (See Fig. 1); **[claim 8]** wherein the at least one auxiliary ground-contacting element is a wheel; **[claim 10]** wherein weight of a rider on one of the passenger platforms is borne primarily by the at least one auxiliary ground-contacting element; **[claim 12]** wherein at least one passenger platform includes at least one seat (30); **[claim 15]** wherein at least one of the passenger platforms includes a substantially vertical support column (26).

Kurschat does not disclose wherein the first support platform is capable of tilting in the fore-aft plane about a tilt axis and a controller configured so that at least one of fore and aft sustained motion of the transporter is based at least on fore-aft tilting of the first support platform. Malick discloses a transporter having a first support platform capable of tilting in the fore-aft plane about a tilt axis and a controller configured so that at least one of fore and aft sustained motion of the transporter is based on fore-aft tilting of the first support platform. At the time of the invention, it would have been obvious to a person of ordinary skill in this art to substitute the transporter disclosed in Malick for the transporter disclosed in Kurschat. The motivation for doing so would have been to provide a vehicle with rapid acceleration and braking and high maneuverability to provide a sporting ride (See column 1, lines 63-66).

Regarding claim 2, the combination of Kurschat and Malick would disclose wherein at least one of the passenger platforms is pivotally coupled to the first support platform in such a manner that fore-aft tilting of the first support platform is substantially independent of the passenger platforms.

Regarding claim 3, the combination of Kurschat and Malick would disclose wherein the first support platform includes a pivot member characterized by a pivot axis proximate to said tilt axis for coupling at least one of the passenger platforms to the first support platform, the pivot axis being perpendicular to the fore-aft plane.

Regarding claim 4, the combination of Kurschat and Malick would disclose wherein the pivot axis coincides with the tilt axis.

Regarding claim 5, Kurschat discloses wherein at least one of the passenger platforms includes an arm having an end for coupling to the pivot member (See Fig. 1).

Regarding claim 6, the combination of Kurschat and Malick would disclose wherein the arm is shaped to avoid contact with the first platform when the first platform is tilting.

Regarding claim 17, Malick discloses wherein the controller commands the motorized drive arrangement such that stability of the first support platform is dynamically maintained.

Regarding claims 24-27, under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). In this case, the device set forth above in the combination of Kurschat and Malick would inherently perform the method required by claims 24-27.

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8. **Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Kurschat (US Patent 5,064,209) and Malick (US Patent 3,399,742) as applied to claims 1 and 7 above, and further in view of McClellan (US Patent 3,387,859).** The combination of Kurschat and Malick disclose the transporter as set forth above, but does not disclose wherein the wheel can swivel about a vertical axis in response to turns made by the transporter. McClellan discloses a platform wherein the wheel can swivel about a vertical axis in response to turns made by the transporter (See the Abstract). At the time of the invention, it would have been obvious to a person of ordinary skill in this art to substitute the swivel wheel disclosed in McClellan for the wheels disclosed in Kurschat. The motivation for doing so would have been to allow the trailer to track in relation to the movement of the transporter.

9. **Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurschat (US Patent 5,064,209) and Malick (US Patent 3,399,742) as applied to claims 1 and 7 above, and further in view of Duncan et al. (US Patent 5,427,390).** The combination of Kurschat and Malick disclose the transporter as set forth above, but does not disclose wherein the one auxiliary ground-contacting element is one of a ski and a skid. Duncan et al. discloses wherein a ski/skid can replace a wheel for a vehicle. At the time of the invention, it would have been obvious to a person of ordinary skill in this art to substitute the ski/skids disclosed in Duncan et al. for the wheel (ground-contacting element) disclosed in Kurschat. The motivation for doing so would have been to allow the transporter to operate on snow.

10. **Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurschat (US Patent 5,064,209) and Malick (US Patent 3,399,742) as applied to claim 1 above, and further in view of Examiner's Official Notice.** The combination of Kurschat and

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Malick disclose the transporter as set forth above, but does not disclose wherein at least one of the passenger platforms is coupled to the first platform via a ball joint or a U-joint. Examiner takes Official Notice that ball joints and U-joints are notoriously old and well known in coupling a trailer to a vehicle. Either joint could be utilized in coupling the trailer to the transporter, and allow the trailer to track the movement of the transporter.

Conclusion

11. The prior art made of record in the accompanying PTO Form 892 and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Allen Shriver whose telephone number is (703) 308-1224. The examiner can normally be reached on Mon-Thurs 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris P. Ellis can be reached on (703) 305-0168. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-1113.

As of May 1, 2003, any response to this action should be mailed to:

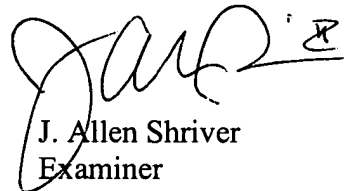
Mail Stop _____
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to: (703) 305-3597 or (703) 305-7687 (for formal communications intended for entry. (703) 746-3852 (for informal communications directly to the Examiner).

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thursday, February 10, 2005

 2/10/05
J. Allen Shriver
Examiner
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JAS